

DEP 1/2 Ref



PATENT MAINTENANCE
DIVISION

2006 AUG 28 PM 3:55

Docket No.: 3782-0110P
(PATENT)

US PATENT & TRADEMARK
OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Christer FAHREUS et al.

Application No.: 09/813,116

Confirmation No.: 8100

Filed: March 21, 2001

Art Unit: 3621

For: METHOD AND APPARATUS FOR
MANAGING VALUABLE DOCUMENTS

Examiner: F. Backer

REQUEST FOR REFUND
(IMPROPER CHARGE OF DEPOSIT ACCOUNT)

MS 16
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I. REFUND REQUEST

This is a request for a refund with respect to the charge to Deposit Account 02-2448 shown on the statement for the month of October 8, 2004 for the above-identified

☒ application

☐ patent

☒ A copy of the monthly statement in which the error referred to occurs, accompanies this request.

Adjustment date: 09/12/2006 ZJUHA1
10708/2004 PLEWIS 00000001 022448 09813116
01 FC:1252 420.00 CR

Birch, Stewart, Kolasch & Birch, LLP

MKM/CMV/ec

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II. FEES CHARGED FOR WHICH REFUND REQUESTED

AMOUNT OF
REFUND
REQUESTED☐ filing fee

☐ search fee

☐ examination fee

☐ surcharge for filing the basic filing
on a date later than the filing date of
the application (37 C.F.R. § 1.16(e))

and/or

☐ surcharge for filing the oath or declaration
on a date later than the filing date of the
application (37 C.F.R. § 1.16(e))

☒ extension of term☐ first month

☒ second month\$ 420.00☐ third month

☐ fourth month

☐ excess claims

☐ issue fee

☐ petition fee

Application No.: 09/813,116

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- ☐ patent maintenance fee _____
- ☐ first maintenance fee _____
- ☐ second maintenance fee _____
- ☐ third maintenance fee _____
- ☐ patent maintenance fee surcharge _____
- ☐ Other: _____
- _____
- _____
- _____

TOTAL REFUND REQUESTED

\$ 420.00

III. EXPLANATION OF WHY CONTESTED CHARGE IS IN ERROR

On May 11, 2004 Applicants received a Restriction Requirement from the U.S. Patent and Trademark Office which set a (3) month reply period. On July 30, 2004 we timely submitted a Response to the outstanding Restriction Requirement, thus we note that no fee was required. Applicants deposit account was charged on October 8, 2004 in the amount of \$420.00 for a Two Month Extension of Time Fee. A copy of the October 2004 Statement of Account (relevant pages), a copy of the Restriction Requirement dated May 11, 2004 and a copy of our Reply to the Restriction Requirement are enclosed as evidence of the above. Applicants therefore request a refund in the amount of \$420.00.

IV. MANNER OF REFUND

Please make refund by crediting Account No. 02-2448.

Application No.: 09/813,116

Docket No.: 3782-0110P

We respectfully request that the attached copy of this letter be returned to us with an indication that the credit has been processed.

Dated:

AUG 25 2006

Respectfully submitted,

By

Michael K. Mutter

Registration No.: 29,680

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

Attachment(s)



PATENT
3782-0110P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Christer FÄHRAEUS Conf.: 8100
Appl. No.: 09/813,116 Group: 3621
Filed: March 21, 2001 Examiner: Firmin BACKER
For: METHOD AND APPARATUS FOR MANAGING
VALUABLE DOCUMENTS

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 30, 2004

Sir:

In reply to the Restriction Requirement dated May 11, 2004,
the following remarks are respectfully submitted in connection with
the above-identified application.

This reply includes: Remarks.

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REMARKS

Claims 1-53 are pending in the present application.

The Examiner has required election in the present application between:

Group I, claims 1-23, 33-52, drawn to managing valuable document, classified in class 705, subclass 64;

Group II, claims 24-32, drawn to data structure for storing two dimensional coordinate, classified in class 382, subclass 181; and

Group III, claim 53, drawn to printing authenticated currency, classified in class 382, subclass 154.

For the purpose of examination of the present application, Applicant elects, with traverse, Group I, claims 1-23, 33-52.

Applicant respectfully traverses the Examiner's restriction requirement. While the Examiner summarizes the reasons in support for restrictability of combination and subcombination groups generally, the Examiner has stated no specifics to support his position that the groups identified in the outstanding Office Action are in fact combination and subcombination, or properly restrictable. The Examiner has not explained which group is believed to be the combination and which groups are considered the subcombinations of his apparent combination and subcombination

Appl. No. 09/813,116

restriction requirement. All of the Examiner's statements concerning the restriction requirement are conclusory there being no factual statements supporting the assertive restrictability. Consequently, since the Examiner has not made a *prima facie* case of restriction, reconsideration and withdrawal of the restriction requirement is believed proper.

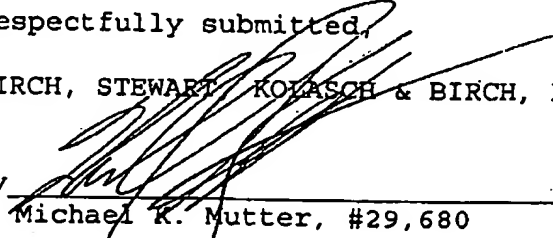
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter (Reg. No. 29,680) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART KOLASCH & BIRCH, LLP

By


Michael K. Mutter, #29,680

MKM/apw
3782-0110P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,116	03/21/2001	Christer Fahraeus	3782-0110P	8100
2292	7590	05/11/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/11/2004

Docketed

8-11-04

Restiction

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/813,116

Applicant(s)

FAHRAEUS, CHRISTER

Examiner

Firmin Backer

Art Unit

3621

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1953.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to a letter for patent filed on March 21st, 2001 in which claims 1-53 are presented for examination. Claims 1-53 are pending in the letter.

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, 33-52, drawn to managing valuable document, classified in class 705, subclass 64.
 - II. Claims 24-32, drawn to data structure for storing two dimensional coordinate, classified in class 382, subclass 181.
 - III. Claims 53, drawn to printing authenticated currency, classified in class 382, subclass 154.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because they are patentably distinct. The subcombination has separate utility such as

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managing valuable document, data structure for storing two dimensional coordinate and printing authenticated currency.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group II and III, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Conclusion

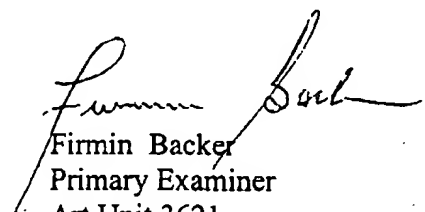
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer
Primary Examiner
Art Unit 3621

May 7, 2004

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United States
Patent and
Trademark Office



Deposit Account Statement

Requested Statement Month: October 2004
 Deposit Account Number: 022448
 Name: BIRCH STEWART KOLASCH & BIRCH
 Attention:
 Address: 8110 GATEHOUSE ROAD
 City: FALLS CHURCH
 State: VA
 Zip: 22042
 Country: UNITED STATES

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
10/01	2	10372821	0446-0143P	2201	\$43.00	\$13,23
10/01	2	10929133	1718-0195PUS2	1202	\$432.00	\$12,80
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